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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/897,455	07/22/97	STACHE	U 2481.1403-02

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HM42/0616

EXAMINER

BADIO, B

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 06/16/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/897,455

Applicant(s)  
Stache et al.

Examiner  
Barbara Badio

Group Art Unit  
1616



☒ Responsive to communication(s) filed on Apr 17, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 3-5, and 7 is/are pending in the application.

Of the above, claim(s) 3 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 4, 5, and 7 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**First Office Action on the Merits of a Continued Prosecution Application**

***Continued Prosecution Application***

1. The request filed on April 17, 1998 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/897,455 is acceptable and a CPA has been established. An action on the CPA follows.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Election/Restriction***

3. Claims 1, 3-5 and 7 are pending in the present application. Since this is a Continued Prosecution Application (CPA), the election of Group I, claims 1 and 4-5 and the species of Example 6 carries forward. Accordingly, claim 3 is withdrawn from further consideration. Claim 7 is similar to canceled claim 2 and will be examined with Group I, claims 1 and 4-5.
4. Applicant's election made with traverse in Paper No. 5 is noted. However, the traversal was on the ground(s) that there is no burden on the examiner to search groups I and III together based on the restriction requirement made in Paper No. 3. In Paper No. 11, groups I and III were combined into one group. Therefore, the present

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restriction is based on two groups (see Paper No. 11). Applicant has not provided any reasons as to why said restriction is not proper.

The requirement is still deemed proper and is therefore made **FINAL**.

5. The examiner notes that upon allowance of the compound claims, process claims reciting compounds of the same scope as the allowed compounds would be rejoined.

***Claim Rejections - 35 USC § 112***

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the identification and definition of R(4).

Claim 7 recites "wherein R(1), A, Y, Z, R(3) and R(4) are defined as in claim 1". The structure of formula I as defined by claim 1 does not identify or define R(4) as recited by claim 7.

***Claim Rejections - 35 USC § 102***

7. The rejection of claims 1-2 and 4-5 under 35 USC 102(b) over Villax et al. ('693) is withdrawn.

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8. The rejection of claims 1-2 and 4-5 under 35 USC 102(b) over Kamano et al. ('172) is withdrawn.

***Claim Rejections - 35 USC § 103***

9. The rejection of claims 1-2 and 4-5 under 35 USC 103(a) over Villax et al. ('693) is withdrawn.

10. The rejection of claims 1-2 and 4-5 under 35 USC 103(a) over Kamano et al. ('172) is withdrawn.

11. The rejection of claims 1-2 and 4-5 under 35 USC 103(a) over Annen et al. ('451) is withdrawn.

12. The rejection of claims 2 under 35 USC 103(a) over Page et al. ('971) is made moot by the cancellation of the instant claim.

13. The rejection of claims 1 and 4-5 under 35 USC 103(a) over Page et al. ('971) is maintained and claim 7 is rejected under 35 USC 103(a) over Page et al. ('971).

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Applicant's argument is based on the various definitions for the different substituents identified on formula I of the reference. Applicant argues that there is no teaching or suggestion by the reference to modify the generic structure taught by the reference by choosing the combination of substituents necessary to obtain the instantly claimed compound(s). The argument is not persuasive for the following reasons.

It is noted that a reference is not limited to its working examples but must be evaluated for what it teaches those of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). In re Chapman, 357 F.2d 418, 148 USPQ 711 (CCPA 1966).

Page et al. teach 17,21-dicarboxylic esters of 4-pregnen-3,20-diones having either an oxo or a hydroxy group in the 11-position and the use of the compounds in the treatment of corticosteroid-responsive dermatosis. The reference also gives a number of exemplified compounds encompassed by the generic structure of formula I which include compounds such as *betamethasone-17-benzoate and betamethasone-17-valerate-21-acetate* (see examples 9 and 19). Betamethasone-17-benzoate and betamethasone-17-valerate-21-acetate differ from the instant compounds by the presence of a hydroxyl or an acetate in the 21-position, respectively. The reference teaches an equivalence between a hydroxyl group and an acyl group in the 21-position and an equivalence between acyl groups having an alkyl and an aralkyl moiety (col. 1, lines 17-55). Therefore, it would have been obvious to the ordinary artisan to modify

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the compound(s) exemplified by the reference making compounds having an aralkyl acyl group in the 21-position with reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole as taught by Page et al.

For these reasons and those given in Paper No. 14, the rejection of claims 1 and 4-5 under 35 USC 103(a) over Page et al. ('971) is maintained and claim 7 is rejected under 35 USC 103(a) over Page et al. ('971).

#### ***Telephone Inquiry Contacts***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Badio whose telephone number is (703) 308-4595. The examiner can normally be reached between 7:30 am and 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

BB  
June 12, 1998

  
ALFRED J. ROBINSON  
PRIMARY EXAMINER  
GROUP 1200